

## REMARKS

### *The Invention*

The invention is directed to a library of adenoviral vectors, wherein each member of the library comprises (i) a first heterologous DNA encoding a first gene product, wherein the first heterologous DNA is common to each member of the library of adenoviral vectors, and (ii) a second heterologous DNA encoding an second gene product, wherein the second heterologous DNA varies between the members of the library of adenoviral vectors.

### *The Pending Claims*

Claims 1, 3-6, 9, 12, and 54 are pending and are directed to the library of adenoviral vectors.

### *Amendments to the Claims*

Claim 1 has been amended to incorporate the subject matter of claim 2. Thus, claim 2 has been cancelled. Claim 54 is new and is supported by the specification at, for example, paragraph [0017]. Accordingly, no new matter has been added by way of these amendments.

### *The Office Action*

Claims 1 and 3 are rejected under 35 U.S.C. §§ 102(b) and (e) as allegedly being anticipated by U.S. Patent 5,733,731 (Schatz et al.) ("the Schatz '731 patent"), and U.S. Patent 6,156,511 (Schatz et al.) ("the Schatz '511 patent"), respectively. Claims 1-6 and 12 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent 6,447,768 (van Zonneveld et al.) ("the van Zonneveld patent"). Reconsideration of these rejections is respectfully requested.

### *Discussion of Rejection under 35 U.S.C. § 102(b)*

Claims 1 and 3 are rejected under Section 102(b) as allegedly being unpatentable over the Schatz '731 patent. This rejection is traversed for the reasons set forth below.

According to the Office Action, the Schatz '731 patent discloses a random peptide library comprising recombinant DNA vectors each encoding a DNA binding protein and a random peptide, which random peptide sequence differs among the members of the library. As a result, the Office Action concludes that the Schatz '731 patent anticipates the subject matter of the pending claims.

The pending claims require a library of *adenoviral* vectors. The library disclosed in the Schatz '731 patent is comprised of recombinant phage- or a plasmid-based DNA vectors (see, e.g., col. 5, lines 30-35, and col. 8, line 60-col. 9, line 8). The Schatz '731 patent does

not disclose nor suggest a library of adenoviral vectors, as required by the pending claims. Accordingly, the Schatz '731 patent does not disclose or suggest the subject matter of pending claims 1 and 3, and the rejection under Section 102(b) should be withdrawn.

*Discussion of Rejection under 35 U.S.C. § 102(e)*

Claims 1 and 3 are rejected under Section 102(e) as allegedly being anticipated by the Schatz '511 patent, while claims 1-6 and 12 are rejected under Section 102(e) as allegedly being anticipated by the van Zonneveld patent. These rejections are traversed for the reasons set forth below.

The application that issued as the Schatz '511 patent is a continuation of the application that issued as the Schatz '731 patent. Thus, the specification of the Schatz '511 patent is identical to the specification of the Schatz '731 patent. Accordingly, the Schatz '511 patent does not anticipate the subject matter of pending claims 1 and 3 for the same reasons as set forth above with respect to the Schatz '731 patent.

The Office Action alleges that the van Zonneveld patent discloses recombinant adenoviral vectors encoding a "common" nitric oxide synthase, a CMV promoter, and a sequence encoding either bFGF or VEGF, thereby anticipating the subject matter of claims 1-6 and 12.

The van Zonneveld patent discloses an adenoviral vector construct wherein the vector comprises a nitric oxide synthetase gene and a gene encoding VEGF or bFGF. While the van Zonneveld patent may describe an adenoviral vector comprising a first heterologous DNA encoding a first gene product and a second heterologous DNA encoding a second gene product, the van Zonneveld patent does not disclose, or even suggest, a *library* of such adenoviral vectors wherein the first heterologous DNA is common to each member of the library of adenoviral vectors and the second heterologous DNA varies between the members of the library of adenoviral vectors, as required by the pending claims.


Accordingly, neither the Schatz '511 patent nor the van Zonneveld patent discloses or suggests the subject matter defined by the pending claims, and the rejection under Section 102(e) should be withdrawn.

*Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

In re Appln. of Kovesdi et al.  
Application No. 09/780,526

Respectfully submitted,

A handwritten signature in cursive script, reading "Melissa E. Kolom". The signature is written in dark ink and is positioned above a horizontal line.

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Date: February 23, 2005